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EXAMINER

BASHORE, ALAIN L

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/966,909
Filing Date: September 27, 2001
Appellant(s): DRUMMOND ET AL.

Ralph Jocke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3-2-07 appealing from the Office action mailed 6-7-06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN / CORRECTED REJECTIONS

The following grounds of rejection are not presented for review on appeal because the examiner has withdrawn them. The grounds of rejection withdrawn are nonstatutory obvious-type double patenting rejections, being unpatentable over claims of U.S. Patent No. 6,702,181 or U.S. Patent No. 7,040,533.

Regarding the nonstatutory obvious-type double patenting rejection maintained at appeal, there is dropped from the rejection as being unpatentable over claims 6, 19, and 20 to U.S. Patent No. 6,796,490.

Regarding claims 9-10, as correctly indicated by appellant, these are dependant from claim 7 such that the rejection of claims 9-10 is corrected in this examiner's answer to be rejected under 35 USC 103(a) as being unpatentable over Joao et al in view of Steward as applied to claim 7, and further in view of Laybourn et al. The appellant has made argument regarding a corrected rejection in his brief.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2001/0051920	Joao et al.	12-2001
6,732,176	Stewart et al	5-2004
6,439,456	Bansal et al.	8-2002
6,480,710	Laybourn et al.	11-2002
5,905,810	Jones et al.	12-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "relatively short" is considered vague and indefinite. What is relatively short to one may not be relatively short to another.

Claim Rejections - 35 USC § 102 / 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, and 18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Joao et al.

Joao et al discloses a method and apparatus comprising: receiving with an automated banking machine at least one first wireless communications signal from a portable wireless device which may be a voice communications device (para 0257; fig 10). There is disclosed sending and receiving first and second network communications to and from a server all through operation of the banking machine (para 0246). There is also disclosed sending through operation of the banking machine at least one second

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wireless communication signal to the portable wireless device corresponding to the second network communication signal (para 0259).

Joao et al discloses a network that is not proscribed to a limited geographical area. Because of this, it is maintained that Joao et al inherently discloses a wide area network or WAN. As an alternative interpretation, inherency is not assumed. If not assumed, it would have been obvious to one with ordinary skill in the art to include such to Joao et al because Joao et al teaches use of the Internet as part of the network (para 0053).

Claims 7, 11, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al as applied to claims above, and further in view of Stewart et al.

Joao et al does not explicitly disclose a "wireless access hub".

Stewart et al discloses a wireless access hub (fig 1) and fees (col 12, lines 2-10).

It would have been obvious to one with ordinary skill in the art to include a wireless access hub as in the claimed relationship because Stewart et al teaches hub access useful in a business environment (col 1, lines 26-43).

It would have been obvious to one with ordinary skill in the art to include fees as claimed in claim 9, because Stewart discloses network access providers (col 12, lines 2-10).

Claims 5, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al as applied to claims above, and further in view of Bansal et al.

Joao et al discloses a voice communication device (para 0027).

Joao et al does not explicitly disclose that the portable wireless device includes memory with modifiable cash value data.

Bansal et al discloses a portable wireless device that includes memory with modifiable cash value data (col 3, lines 45-57).

It would have been obvious to one with ordinary skill in the art to include disclose that the portable wireless device includes memory with modifiable cash value data because Bansal et al teaches cash transaction are made by use of wireless devices is desired (col 1, lines 21-41).

Claims 2, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al as applied to claims above, and further in view of Laybourn et al.

Claim 9-10 are rejected under 35 USC 103(a) as being unpatentable over Joao et al in view of Steward as applied to claim 7 above, and further in view of Laybourn et al.

Joao et al nor Stewart et al disclose a usage fee or a fee charged responsive to device enabled to communicate with network.

Laybourn et al discloses a fee charged responsive to device enabled to communicate with network (col 1, lines 18-25).

It would have been obvious to one with ordinary skill in the art to include a fee charged responsive to device enabled to communicate with network because Laybourn et al teaches such as conventional in the wireless art (col 1, lines 20-21).

Claims 3, 8, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al as applied to claims above, and further in view of Jones et al.

Joao et al does not disclose a cash dispenser (responsive to input from the wireless device) from the automated banking machine.

Jones et al discloses dispensing cash from the automated banking machine using a cash dispenser (col 2, lines 42-46; fig 1a).

It would have been obvious to one with ordinary skill in the art to include a cash dispenser of Jones et al because Joao et teaches dispensing cash per se (para 0189).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6 and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 15, and 21 of U.S. Patent No. 6,796,490. Although the conflicting claims are not identical, they are not patentably distinct from each other because recitations encompass what is claimed by the instant application, i.e.: "signals" encompass "messages".

(10) Response to Argument

Regarding claim 17 and the 35 USC 112, second paragraph rejection of that claim, appellant is quite correct in the assessment that the term "relatively short" would be understood regarding "Bluetooth" and "IR based systems". Claim 17 is not limited to Bluetooth and IR based systems so there is no such metes and bounds present. The specification does not present a formal definition for "relatively short" which can be relied upon. Merely reciting types of systems does not enable one with ordinary skill in the art to know what "relatively short" would encompass with all systems not mentioned in appellants specification, nor with what a future system would encompass.

Regarding the rejection of claims 1, 4, 6, and 18 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Joao et al, appellant is quite correct that there is not found in Joao et al the term "automated banking machine", the term "server", or the term "wide area network". Regarding "automated banking machine", since there is no formal definition provided in the specification, this is understood to mean any type of machine that has at least some automation for use at least in banking. The "electronic cash transaction device" to Joao et al appears to meet that definition. Regarding "server", since there is no formal definition provided in the specification, this is understood to mean any means any part of a computer or program that responds to commands from a client. Also, paragraph 0253 indicates a "server computer" present. The CPU to Joao et al appears to meet the definition for a "server". Regarding "wide area network", that has been explained in the rejection of record as being inherent or in the alternative as obvious. As shown in figure 10 and as described in paragraphs 0254-0255, there is clearly disclosed that a portable device can go to bank to server and back to bank and back to a portable device.

Regarding the rejection of claims 7, 11, and 16-17 under 35 USC 103 as obvious under Joao et al and Stewart, appellant is correct that Stewart does not disclose an "automated banking machine". Stewart is combined under an obviousness rejection for the reason as disclosed in the rejection above. The Internet is described in Joao et al as

described in the rejection above, and In Stewart (see fig 1). Regarding "RF communication", Joao et al discloses telephone (307) which would encompass a "RF communication". Regarding "relatively short distance", the reference to Stewart describes use in an airport environment, such that to encompass "relatively short". It would have been obvious to include "relatively short" because different business environments require different space requirements for business functions in absence of unexpected or unobvious results.

Regarding the rejection of claims 5, 13-15 under USC 103 as obvious under Joao et al and Bansal, since there is a debit from a cash card disclosed, there must be a modifying of data representative of cash value, even if that value is a one time operation to zero value. The broad definition to a banking machine would allow the cash card to Bansal to be considered a "banking machine" as an alternative interpretation.

Regarding the rejection of claim 2 under USC 103 as obvious under Joao et al and Laybourn, the rejection has been corrected (and as argued by appellant) to also include claims 9-10 rejected under 35 USC 103(a) as being unpatentable over Joao et al in view of Stewart as applied to claim 7 above, and further in view of Laybourn et al. The claims by appellant do not preclude a monthly service fee as the fee required to communicate.

Regarding the rejection of claims 3, 8, and 12 under USC 103 as obvious under Joao et al and Jones, the rejection is combined for the reasons as indicated in the rejection of record.

Regarding the sole nonstatutory obviousness-type double patenting rejection of record, there is claimed in the '490 patent a "remote host system" which in the instant application there is claimed a server and WAN. It would have been obvious to one with ordinary skill in the art to utilize a server and WAN as the remote host system because a host in its broadest definition is: "a main computer in a system of computers or terminals connected by communication links".

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

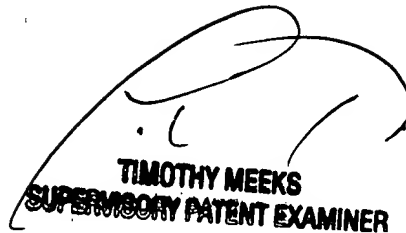


**ALAIN L. BASHORE
PRIMARY EXAMINER**

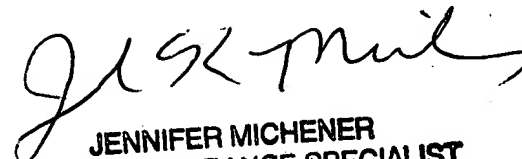
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